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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,096	10/05/2006	Kym John Keightley		1708

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BIO INTELLECTUAL PROPERTY SERVICES (BIO IPS) LLC
8509 KERNON CT.
LORTON, VA 22079

EXAMINER

TALBOT, MICHAEL

ART UNIT	PAPER NUMBER
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3722

MAIL DATE	DELIVERY MODE
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09/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/551,096	Applicant(s) KEIGHTLEY, KYM JOHN	
	Examiner Michael W. Talbot	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

(a) Foreign application AU2003901440, of which Applicant is requesting foreign priority, incorrectly cites the foreign filing date as 28 March 2005. It is believed that the proper filing date of foreign application AU2003901440 is 278 March 2003.

Specification

2. The disclosure is objected to because of the following informalities:

Refer to page 6, line 30, the character reference "treaded member 12" should be changed so as to read --threaded member 12--.

Appropriate correction is required.

Claim Objections

3. Claims 2 and 12 are objected to because of the following informalities:

Claim 2 recites the limitation "the cutting diameter" twice within line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "the cutting surface" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "the cutting face" in line 2. There is insufficient antecedent basis for this limitation in the claim. For examination purposes and as best understood, the claim limitation "face" has been examined as being "surface".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation "said cutting surface" in line 1. There is insufficient antecedent basis for this limitation in the claim. For examination purposes and as best understood, claim 13 has been examined as being dependent upon claim 12 (where the claim limitation of a cutting surface of the second hole saw was first introduced), in lieu of being dependent upon claim 10 as presented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4 and 6-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson '213. Anderson '213 shows in Figures 1-3 an improved hole saw boss (46) including a threaded member (46) adapted to accommodate at least two hole saws (12,12A) of different diameters. Anderson '213 shows the threaded member incorporating a first threaded portion engaging a threaded bore (20) of a first hole saw (12) and a second threaded portion engaging a threaded bore (20A) of a second hole saw (12A), wherein a cutting diameter of the first hole saw is larger than a cutting diameter of the second hole saw (Fig. 3). Anderson '213 shows the boss including a base member (28,32) to which the threaded member is connected (Fig. 2).

Art Unit: 3722

Anderson '213 shows the first and second threaded portion diameters correspondingly engage with commonly available hole saw threaded bore diameters (col. 3, lines 1-34 and col. 4, lines 12-28 and 56-63). Anderson '213 shows at least one threaded portion is of a length capable of accommodating (via extended length shown to the left of the inner hole saw cutter 12A as shown in Fig. 3) more than one hole saw of different cutting diameters (Fig. 3 and col. 4, lines 12-28 and 56-63). Anderson '213 shows the base member and the threaded member include a central aperture (50) adapted to allow a drill bit (66) to fit through (Figs. 1 and 3). Anderson '213 shows the boss including a connection means (via integral with boss) which is configured to engage a mandrel (38,40) or drive means. Anderson '213 shows the second hole saw is chosen to fit snugly within an existing aperture of a work piece, wherein the first hole saw is adapted to drill a hole larger than the existing hole into the work piece (col. 4, lines 12-28). Anderson '213 shows a cutting surface (26A) of the second hole saw extending beyond a cutting surface (26) of the first hole saw (Fig. 3), and the cutting surface of the second hole saw contacting the planar surface of the work piece before the cutting surface of the first hole saw (col. 4, lines 12-28 and 56-63).

8. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Pidgeon '189. Pidgeon '189 shows in Figure 3 an improved hole saw boss (49,50,51,52) including a threaded member (50) adapted to accommodate at least two hole saws (8,32) of different cutting diameters, a base member (43) having at least one notch (45,45a), at least one drive pin (47,47a) configured to engage both the at least one notch on the base member and an existing apertures (9,9a) on at least one of the hole saws (col. 7, lines 1-23).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3722

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson '213 in view of Despres '338. Anderson '213 lacks the hole saw boss having a first and second portions with diameters in a stepped down configuration.

Despres '338 shows in Figures 1-11 a hole saw boss (50) having a first (61) and second (63) portions with diameters in a stepped down configuration. In view of this teaching of Despres '338, it would have been obvious to one of ordinary skill in the art to modify the hole saw boss of Anderson '213 to include a stepped down boss configuration as taught by Despres '338 to accommodate different sized attachment bore sizes exhibited on commonly constructed hole saws with various cutting diameters, thus improving the versatility of the hole saw assembly (col. 13, lines 37-41).

11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pidgeon '189. Pidgeon '189 discloses the claimed invention except for the drive pins being of a magnetized material composition. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to manufacture the drive pins from any magnetized material composition for the purpose of improving the driving contact area between two parts and/or to eliminate loss of the driving pins during assembly/disassembly, because it has been held to be within the general skill of a worker in the art to select a (known finishing method or known material composition) on the basis of its suitability (in producing a known finishing surface or for the intended use) as a matter of obvious design choice.

Conclusion

12. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's

Art Unit: 3722

office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mrs. Monica S. Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MWT
Examiner
10 September 2007

Monica S. Carter
MONICA CARTER
SUPERVISORY PATENT EXAMINER